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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---------------------------------|-------------|----------------------|---------------------|------------------|
| 10/032,215 | 12/21/2001 | Steward D. Elsegood | BOSSCOM.003AUS | 3460 |
| 20995 | 7590 | 12/23/2003 | EXAMINER | |
| KNOBBE MARTENS OLSON & BEAR LLP | | | SAVAGE, MATTHEW O | |
| 2040 MAIN STREET | | | ART UNIT | |
| FOURTEENTH FLOOR | | | PAPER NUMBER | |
| IRVINE, CA 92614 | | | 1723 | |

DATE MAILED: 12/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/032,215

Applicant(s)

ELSEGOOD, STEWARD R

Examiner

Matthew O Savage

Art Unit

1723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 4-15, 19, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Reinosa.

With respect to claim 1, Reinosa discloses and an adapter including a perforated upper portion 10 and a perforated lower portion 10, a centrally located opening 42 passing through the perforated upper portion and perforated lower portion a removable hollow insert 24 mounted inside the opening extending through the perforated upper portion and the perforated lower portion and providing a first threaded portion 56 adapted to engage a threaded stud a second threaded portion 54 adapted to mount to a filter and a magnet 26 disposed within said adapter body for removing metallic particles from the fluid.

Regarding claim 4, Reinosa discloses the perforated upper portion as including a gasket 28.

Regarding claims 5 and 6, Reinosa discloses the perforated upper and lower portions as including a circular pattern of perforations 16.

Claims 7-9 relate to intended use and carry no patentable weight.

With respect to claim 10, Reinosa discloses an adapter including a cylindrical adapter body including a perforated upper portion 10 and a perforated lower portion 10, a centrally located opening 42 passing through the perforated upper portion and the perforated lower portion 24 a removable hollow insert mounted inside the opening and extending through the perforated upper portion and the perforated lower portion and providing a first connection means 56 adapted to engage a connection means on a fluid source and a second connection means 54 adapted to mount onto a filter and a magnet disposed within the adapter body for removing metallic particles from the fluid.

As to claim 11, Reinosa discloses first connection means 56 in the form of a first threaded connection and second connection means in the form of a second threaded connection.

Regarding claim 12, Reinosa discloses the perforated upper portion as including a gasket 28.

Regarding claims 13 and 14, Reinosa discloses the perforated upper and lower portions as including a circular pattern of perforations 16.

Claim 15 relates to intended use and carries no patentable weight.

With respect to claim 19, Reinosa discloses the steps of inserting a magnet 26 in a perforated lower portion 10 of a housing of an adapter, enclosing the magnet in the adapter by attaching a perforated upper portion 10 of a housing of the adapter to the perforated lower portion (e.g., via means 22), and inserting a hollow insert 25 in a centrally located opening 42 passing through the perforated upper portion and the perforated lower portion.

Regarding claim 20, Reinosa discloses attaching a gasket 28 to the perforated upper portion.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-18, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hueber et al in view of Lewis.

With respect to claim 1, Hueber et al disclose an adapter (see FIG. 1) including a perforated upper portion and a perforated lower portion, a centrally located opening passing through the perforated upper portion and perforated lower portion a hollow insert (e.g., including parts 13 and 19) mounted inside the opening extending through the perforated upper portion and the perforated lower portion (see FIG. 1) and providing a first threaded portion 13 adapted to engage a threaded stud a second threaded portion 19 adapted to mount to a filter, and a magnet 17 disposed within said adapter body for removing metallic particles from the fluid. Hueber et al fail to specify the hollow insert as extending completely through the upper perforated portion and as being removable. Lewis discloses a hollow insert 15 that extends through perforated upper and lower portions of an adapter and that is removable and suggests that such an arrangement facilitates assembly of the device. It would have been obvious to have

modified the adapter of Hueber et al so as to have included a hollow insert that was removable as suggested by Lewis in order to facilitate assembly of the device.

Concerning claim 2, Hueber et al disclose a magnet 17 in the form of a ring.

Concerning claim 3, Hueber et al discloses a ring support 18 for mounting the magnet to the adapter body such that a gap exists between the magnet and the perforated upper portion.

Regarding claim 4, Hueber et al disclose the perforated upper portion as including a gasket 22.

Regarding claims 5 and 6, Hueber et al disclose the perforated upper and lower portions as including a circular pattern of perforations 24, 25.

Claims 7-9 relate to intended use and carry no patentable weight.

With respect to claim 10, Hueber discloses an adapter including a cylindrical adapter body (see FIG. 1) including a perforated upper portion and a perforated lower portion, a centrally located opening passing through the perforated upper portion and the perforated lower portion a removable hollow insert mounted inside the opening and extending through the perforated upper portion and the perforated lower portion and providing a first connection means 13 adapted to engage a connection means on a fluid source and a second connection means 19 adapted to mount onto a filter and a magnet 17 disposed within the adapter body for removing metallic particles from the fluid. Hueber et al fail to specify the hollow insert as passing completely through the upper perforated portion and as being removable. Lewis discloses a hollow insert 15 that extends through perforated upper and lower portions of an adapter and that is

removable and suggests that such an arrangement facilitates assembly of the device. It would have been obvious to have modified the adapter of Hueber et al so as to have included a hollow insert that was removable as suggested by Lewis in order to facilitate assembly of the device.

As to claim 11, Hueber et al disclose first connection means in the form of a first threaded connection 13 and second connection means in the form of a second threaded connection 19.

Regarding claim 12, Hueber et al disclose the perforated upper portion as including a gasket 28.

Regarding claims 13 and 14, Hueber et al disclose the perforated upper and lower portions as including a circular pattern of perforations 16.

Claim 15 relates to intended use and carries no patentable weight.

As to claim 16, Hueber et al discloses a magnet 17 in the shape of a ring.

Concerning claim 17, Hueber et al discloses a ring support 18 for mounting the magnet to the adapter body such that a gap exists between the magnet and the perforated upper portion.

As to claim 18, Hueber et al disclose the ring support 18 as including three pieces (e.g., defined by fibers of the pad 18) forming notches corresponding to the thickness of the magnet).

As to claim 30, Hueber et al disclose a plurality of magnet holders (e.g., the fibers of the pad 18) positioned along the inner periphery of the perforated lower portion.

Claims 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Vogrin in view of Fearnhead and Lewis.

With respect to claim 19, Vogrin discloses inserting a magnet 17 (see FIG. 1) in an adapter housing 11 having an upper perforated portion and a lower perforated portion, and inserting a hollow insert 13 in a centrally located opening passing through the perforated upper portion, the perforated lower portion, and the magnet. Vogrin, as best understood, fails to specify placing the magnet in the perforated lower portion followed by enclosing the magnet in the adapter by attaching a perforated upper portion of a housing to the perforated lower portion. Fearnhead discloses that its known to enclose a filter member within a housing by first placing the filter member in a lower portion 11 of the housing followed by enclosing the filter member in the housing by attaching a perforated upper portion 13 to the lower portion, and suggests that such steps provide a strong and leak proof filter assembly. It would have been obvious to have modified the method suggested by Vogrin so as to have include the method of enclosing the filter member in a housing as suggested by Fearnhead in order to provide a strong and leak proof housing. Vogrin and Fearnhead fail to specify the hollow insert as passing completely through the upper perforated portion. Lewis discloses a hollow insert 15 that extends through perforated upper and lower portions of an adapter and suggests that such an arrangement facilitates assembly of the device. It would have been obvious to have modified combination of methods suggested by Hueber et al and Fearnhead so as to have included a hollow insert that was passed completely through the upper perforated portion of the adapter as suggested by Lewis in order to facilitate assembly of the device.

Concerning claim 20, Vogrin discloses attaching a sealing gasket 22 to the upper portion (see FIG. 1).

Regarding claim 21, Vogrin discloses mounting a ring support and magnet in a housing (see the upper ring surrounding part 13 in FIG. 3). Vogrin fails to specify mounting the ring support to the magnet and then inserting the ring support along with the magnet into the lower portion, however, the change in the sequence of process steps is considered obvious absent any evidence of unexpected results since the magnet and ring support of Vogrin are capable of being mounted in such a manner.

Claims 22-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hueber et al in view of Paton.

With respect to claim 22, Hueber discloses an adapter including a cylindrical adapter body (see FIG. 1) including a perforated upper portion and a perforated lower portion, a centrally located opening passing through the perforated upper portion and the perforated lower portion, a hollow insert mounted inside the opening and providing a first connection means 13 adapted to engage a connection means on a fluid source and a second connection means 19 adapted to mount onto a filter, and a magnet 17 disposed within the adapter body for removing metallic particles from the fluid, the magnet having a central opening circumscribing the hollow insert. Hueber et al fails to specify the central opening as allowing flow between the insert and the magnet. Paton discloses the concept of providing a magnet 28 with an opening circumscribing an insert 21 so as to allow flow there between and suggests that such an arrangement increases

the surface area of the magnet available for collecting ferromagnetic. It would have been obvious to have modified the magnet of Hueber et al so as to have included an opening capable of allowing flow between the magnet and insert as suggested by Paton in order to increase the surface area of the magnet available for collecting ferromagnetic particles.

Concerning claim 23, Hueber et al disclose a magnet 17 in the form of a ring.

Concerning claims 24 and 28, Hueber et al discloses a ring support 18 for mounting the magnet to the adapter body such that a gap exists between the magnet and the perforated upper portion.

Regarding claim 25, Hueber et al disclose the perforated upper portion as including a gasket 22.

Regarding claims 26 and 27, Hueber et al disclose the perforated upper and lower portions as including a circular pattern of perforations 24, 25.

As to claim 29, Hueber et al disclose a plurality of magnet holders (e.g., the fibers of the pad 18) positioned along the inner periphery of the perforated lower portion.

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew O Savage whose telephone number is 703-308-3854. The examiner can normally be reached on Monday-Friday, 7:00am-3:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda W. Walker can be reached on 703-308-0457. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

M. Savage
Matthew O Savage
Primary Examiner
Art Unit 1723

mos
December 4, 2003